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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,686	10/03/2006	James Roy Easter	45568-00542	1119
25231 7590 12/16/2010 MARSH, FISCHMANN & BREYFOGLE LLP 8055 East Tufts Avenue Suite 450 Denver, CO 80237				
EXAMINER				
DANEGA, RENEE A				
ART UNIT		PAPER NUMBER		
3736				
MAIL DATE		DELIVERY MODE		
12/16/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/549,686

Applicant(s)

EASTER ET AL.

Examiner

Renee Danega

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-942)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date 10/16/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 40-45 objected to under 37 CFR 1.75 as being a substantial duplicate of claims 24, 30, 31, 32, 29, and 26, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 31 and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner is unsure what "tangs" are with regards to the apparatus as they are not mentioned in the specification or pointed out in any of the Figures. It is conceivable that the applicant meant "tangs" to refer to inward pressure applied by "receiver ends" [para 70] but again these are not identified in the drawings and examiner is uncertain what elements are being referred to. The only ball appears to be element (228), however it may be that there should be one on element (304) and the tip of (306) near the arrows at "B" are the tangs (Figure 10).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 24-45, is rejected under 35 U.S.C. 35 U.S.C. 103(a) as being unpatentable over Engebretson et al. (US 5085628) in view of Metzler et al (US 5702342)

Regarding claims 24-25, 30, 33-34, and 39-42, Engebretson teaches an implantable hearing aid and actuator comprising a first apparatus to couple with a middle ear component of a patient and including at least one surface discontinuity (80) located and adapted for inducing patient tissue attachment between the middle ear component and the first apparatus; a second apparatus operable to communicate axial vibrations (26) to the first apparatus, wherein the first and second apparatus are selectively connectable and disconnectable by a user within a middle ear of a patient; and a transducer having a body (39) defining an aperture extending through a first side thereof, said second apparatus (26) extending through said aperture, and a driver (70) operable to drive the second apparatus in response to transducer drive signals (26) and thereby stimulate the middle ear component when connected to the first apparatus, Engebretson doesn't teach the second apparatus is selectively advanceable by a user relative to the transducer body through the aperture so as selectively position said second apparatus independent from the operation of the driver. However, Metzler teaches mounting a stimulating apparatus (65) using a ball (54) and sliding it into a housing aperture in order to permit omnidirectional movement of the device via the ball particularly for use in hearing aid systems (Figures 1-2). It would have been obvious in view of Metzler to

provide a ball mount for inserting the first and second apparatus into the transducer housing of Engebretson to allow omnidirectional movement in stimulation.

Regarding claims 26, 35, and 45, Engebretson teaches the first (80) and second apparatus (26) are separate structures from the transducer (70) but doesn't expressly teach at least the second structure is insertable into the aperture of the transducer body. However, Metzler teaches his device with the main body (52) insertable into a channel (34) permitting replaceable parts and individual replacement of components (Figure 2). It would have been obvious in view of Metzler to provide for insertion of the first and second apparatus of Engebretson in order to provide for removal and replacement of individual parts in the system.

Regarding claims 27-28 and 36-37, Engebretson teaches a coupler (72) for coupling and disconnecting the second element within the aperture of the transducer body (39) (Figures 5-6).

Regarding claims 29 and 38, 44, Engebretson teaches the at least one surface discontinuity comprises at least one of a complex surface shape (80), surface pores, and surface asperities (Figure 6).

Regarding claims 32 and 43, Engebretson teaches the first (76) and second (26) apparatus are connected and movable relative each other capable of reducing load pressures (96) (Figure 6).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Renee Danega whose telephone number is (571)270-3639. The examiner can normally be reached on Monday through Thursday 8:30-5:00 eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RAD

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736